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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/673,107	09/27/2003	John R. Klug	1948/US/2	2313

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DORSEY & WHITNEY, LLP  
INTELLECTUAL PROPERTY DEPARTMENT  
370 SEVENTEENTH STREET  
SUITE 4700  
DENVER, CO 80202-5647

EXAMINER

COSIMANO, EDWARD R

ART UNIT	PAPER NUMBER
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3639

DATE MAILED: 06/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

17

<b>Office Action Summary</b>	<b>Application No.</b> 10/673,107	<b>Applicant(s)</b> KLUG, JOHN R.	
	<b>Examiner</b> Edward R. Cosimano	<b>Art Unit</b> 3639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 June 2005.  
 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7,9 and 11-20 is/are pending in the application.  
 4a) Of the above claim(s) none is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) 1-3,7,9 and 11-20 is/are rejected.  
 7) ☒ Claim(s) 4-6 is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.  
 10) ☒ The drawing(s) filed on 19 November 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☐ All    b) ☐ Some \*    c) ☐ None of:  
     1. ☐ Certified copies of the priority documents have been received.  
     2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
     3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
 \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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1. Applicant's claim for the benefit of an earlier filing date under 35 U.S.C. § 119(e) is acknowledged.
2. The proposed drawing correction filed 19 November 2004 has been approved.
3. The disclosure is objected to because of the following informalities:

A) applicant must update:

(1) the continuing data in paragraph number 1 on page 1 as amended on January 27, 2004, "This application claims ... co-pending application serial no. 10/673,073, ... which is also incorporated herein by reference.";

with the current status of each of the referenced applications, e.g., --now abandoned--, or --now patent #?--, or --which is abandoned and now serial number #?--, etc.

B) the following errors have been noted in the specification:

(1) it is noted that the title of the patent application identified in paragraph number 1 of the specification does not match the title provided in this paragraph, on page 1 paragraph number 1 should read as follows, --[0001] This application claims priority to United States Provisional No. 60/452,369, entitled "METHOD AND APPARATUS FOR IDENTIFYING, MANAGING, AND CONTROLLING COMMUNICATIONS" naming John R. Klug as Inventor and filed on March 5, 2003, the entirety of which is hereby incorporated by reference. This application is also related to co-pending application serial no. [[10/673,017]] 10/673,073 (Attorney Docket No. 1948/US/3). also entitled "METHOD AND APPARATUS FOR IDENTIFYING, MANAGING, AND CONTROLLING COMMUNICATIONS," naming John R. Klug as Inventor and filed on September 27, 2003, the entirety of which is also incorporated herein by reference.--.

Appropriate correction is required.

4. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.52, 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(h)-1.121(i).

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5. For the purposes of the following rejections the examiner has interpreted a “frank” to be a sender designated/assigned indication of the priority level, e.g. first class, priority, bulk/spam, etc. for a communication, which is consistent with applicant’s disclosure in paragraphs number 33, 89, 118 & 168-179. Where in:

A) claims 1-6 a system generates the frank based on a user/sender’s request;

B) claims 7, 9, 12 & 13 attached a frank to a communication; and

C) claims 13-20 process a communication based on whether or no the communication has been franked.

6. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

(c) Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

6.1 Claims 1-3, 7, 9, 11, 12 & 14-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Begeja (6,175,621) in view of recognized equivalents.

6.1.1 In regard to claim 1, Begeja (‘621) discloses a computer implemented system/process which under the control of an operating system stored in the memory of the of the system provides the function of generating a frank or indication of the relative importance of a communication as specified by the sender of the communication in order to increase the likelihood that the recipient will receive the communication. To this end the system/process of Begeja (‘621) includes a first device which permits the sender of a message to request a frank that would indicate the relative importance of the communication which has been specified by

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the sender of the communication. Next, a second device, after receiving a request by the sender of a communication to change the status of a communication, would based on the received request, generate a frank that would indicate that the sender has requested a different status for the message, such as a priority message in the point of view of the sender. The generated frank is then attached to and transmitted with the communication to the recipient where the communication is processed by the recipient's system based on the request level of relative importance of a communication as specified by the sender of the communication.

6.1.2 Although, the communication of Begeja ('621) is a voice communication instead of the text of email communication as in the preferred embodiment of the instant invention, it would have been obvious at the time of the invention that the system/process of Begeja ('621) could be applied to any equivalent type of communications system, since as applicant, admits in paragraph number 6 on pages 2-3, the user of any number of different types of equivalent communication systems have the same problem of whether or not to receive unwanted communications and hence the user/sender with in the system/process of Begeja ('621) could provide to the recipient and indication of the importance of the communication.

6.1.3 In regard to the storing of the generated frank in claim 9, since all computer implemented systems require a memory to store program instructions as well as any type of generated temporary data/information such as a working memory, it would have been obvious at the time of the invention that the system/process of Begeja ('621) would at least store the generated frank at some point between the generation of the frank and the attachment of the frank to the communication so that the system would not lose the data/information that represents the generated frank in the system/process of Begeja ('621).

6.1.4 In regard to claims 13-16, it is further noted that the received franked communications with in the system/process of Begeja ('621) are processed according to the franked indication of the sender specified importance of the communication. That is a franked communication, which meets the ruled criteria of the recipient will be processed accordingly to a first set of the recipient's rules regarding received communications and accordingly indicated to the recipient. Whereas either an unfranked communication or a franked communication that did not meet the ruled criteria of the recipient would be processed accordingly to a second set of the recipient's rules regarding received communications and accordingly indicated to the recipient.

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6.1.5 In regard to the location of the recited components as recited in claims 11, 12 & 17-20, since the computer implemented system/process of Begeja ('621) performs the functions of the recited system as set forth in the claims, but that the components as recited in the claims may not be located as recited in the claims, it would have been obvious at the time of the invention that the system/process of Begeja ('621) could be modified to relocate or rearrange the various component of the system/process of Begeja ('621) into any one of the possible suitable various different groupings/configurations of the required components that would provide the same result absent applicant's showing of a new and unexpected results from a particular grouping/configuration of the required components that would provide the same result. Note that as further evidence that the regrouping/relocation of machine or process functions are obvious, since the Court has stated in either:

A) In re Japikse, 86 U.S.P.Q. 70 @ 73 (CCPA, 1950) that it is not invention to merely move the location of a device, since the new position does not affect, i.e. modify the operation of the device; or

B) In re Larson et al, 144 U.S.P.Q. 347 @ 349 (CCPA, 1965) that it is not invention to merely make various parts integral without unexpected results; or

C) In re Dulberg, 129 U.S.P.Q. 348 @ 349 (CCPA, 1965) that it is not invention to merely make various parts separable without unexpected results if access to something is desirable.

7. The following is an Examiner's Statement of Reasons for Allowance:

A) in regard to claim 4, the prior art does not teach or suggest a communication processing system in which a receipt module determines if a communication is franked and then a verification module verifies the authenticity of the frank attached to the communication. Claims 5-6 are allowable for the same reason.

8. Response to applicant's arguments.

8.1 All rejections and objections of the previous Office action not repeated or modified and repeated here in have been over come by applicant's last response.

8.2 As per the objection to the disclosure regarding the status of the copending application, since the status of the referenced application has not changed this objection has been maintained.

9. The examiner has cited prior art of interest, for example:

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A) Lotan et al (3,848,233) discloses that a receiving system will process received data/information differently based on the priority level assigned to the communications channel used to transmit the data/information.

B) Schutzman et al (5,627,764) discloses that the receiver's rules are used to process received messages based on the content of the received message.

10. Claims 4-6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. The shorten statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (571) 272-6802. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (571) 272-6812. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-3600.

12.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (571) 273-6802.

12.2 The fax phone number for OFFICIAL FAXES is (703) 872-9306.

12.3 The fax phone number for AFTER FINAL FAXES is (703) 872-9306.

06/16/05

  
Edward R. Cosimano  
Primary Examiner A.U. 3639